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In re Application of :
Johann Eibl :
Serial No.: 09/998,575 : PETITION DECISION
Filed: November 16, 2001 :
Attorney Docket No.: A34720-PCT-USA-A :

This is in response to the petition under 37 CFR § 1.181 and 37 CFR § 1.144, filed July 12, 2004, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed on November 16, 2001, and contained claims 1-130.

In a first Office action, mailed September 29, 2003, the examiner set forth a restriction requirement under 35 U.S.C. 121, as follows:

> Group I, claims 1-104, drawn to a topical medicament for stopping bleeding.
> Group II, claims 105-106, drawn to a method of making fibrinogen solution.
> Group III, claims 107-108, drawn to a fibrinogen solution with specific purity properties.
> Group IV, claim 109, drawn to a process of obtaining a pathogen-free active substance.
> Group V, claim 110, drawn to a method of binding an active agent to a biological matrix.
> Group VI, claims 111-112, 114-115, drawn to a first process of making a fibrin gel with specific hydration with a drying agent.
> Group VII, claims 113, 116, drawn to a second process of making a fibrin gel with specific hydration with pressure.
> Group VIII, claims 117-118, drawn to a third process of making a fibrin gel with metallic ions.
> Group IX, claims 119-120, drawn to a lyophilized fibrin gel with plasticizer.
> Group X, claim 121, drawn to a method of making a viscous fibrin gel.
> Group XI, claim 122, drawn to a method of determining adherence to a fibrin clot.
> Group XII, claims 124-130, drawn to a method of treating wounds with a medicament.

The examiner reasoned that the inventions of Group I and group XII were related as product and process of use, and the product had use as a glue. The examiner also reasoned that Inventions I and II, IV-VII, and IX-XI were unrelated as Group I is a composition whereas Groups II, IV-VII, and IX-XI are drawn to various methods. Finally, the examiner reasoned that Inventions I, III, and VI were unrelated as they correspond to distinctly different compositions; namely, a medicament, a solution and a lyophilized gel, respectively.

The examiner also required a species election based on the fact that claims 1-104 were generic to a plurality of patentably distinct species of active agent groups, and a plurality of species within each active agent group comprising:

1) structural proteins-for species, see claims 2-4
2) cell stimulating factors-for species, see claims 5-8
3) enzymes and enzyme inhibitors-for species, see claims 9-16
4) antiadherent, antioxidant, and antimicrobials-for species, see claims 17-32
5) blood coagulation zymogens-for species, see claims 33-64
6) particulate cell elements-for species, see claims 65-95

Applicant was also required to (A) elect a single disclosed species of active agent Group 1-6, and (B) within that elected active agent Group, to further elect a specific specie of said active agent group, if applicant elected Group I.

On January 2, 2004, applicant filed a Response and elected Group I, claims 1-104, drawn to a topical medicament, without traverse. Applicant also elected species (A) structural proteins, and elected species (B) allogenic collagen, with traverse. Applicant agues that the species election requirement does not relate to a species of element (i)-(iv), but instead to a further addition (v) to the generic composition of claim 1.

The examiner mailed a non-final Office action to applicant on March 12, 2004, in which the examiner acknowledged applicant's election without traverse of group I, claims 1-104 and acknowledged the election with traverse of allogenic collagens as the structural protein. The examiner repeated the species election requirement and reasoned that the additional components were active ingredients that would materially affect the basic and novel characteristics of the claimed invention, and that it was proper to consider that searching each and every one of the added active ingredients could entail burden due to the fact that each of these ingredients requires a separate search as these active ingredients are not classified together or recognized in the art as being coextensive.

Applicant replied on July 12, 2004 by filing this petition. Applicant also filed a full reply to the Office action on July 12, 2004.

DISCUSSION

MPEP 818.03(c) and 37 CFR § 1.144 state that after a final requirement for restriction, the applicant may petition the Commissioner to review the requirement. In this case, the requirement for restriction has not been made final.

Therefore, applicant's petition is DISMISSED as premature.

It is pointed out to applicant that an election of species is designed to provide a starting point for a search. See MPEP 803.02 for a complete explanation of restriction practice for Markush-type claims.

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce M. Kisliuk
Director, Technology Center 1600